

DOCKET NO.: ISIS-3455

PATENT

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP NO. 1655

TECH CENTER 1600/2900

NOV 19 2002

RECEIVED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Cowser et al.

Serial No.: 09/295,463

Group Art Unit: 1631

Filing Date: April 13, 1999

Examiner: Marschel

For: IDENTIFICATION OF GENETIC TARGETS FOR MODULATION BY
OLIGONUCLEOTIDES AND GENERATION OF OLIGONUCLEOTIDES FOR
GENE MODULATION

A21/D
Plunkett
11/20/02

EXPRESS MAIL LABEL NO: EV 160977710 US

DATE OF DEPOSIT: November 12, 2002

Box AF
Assistant Commissioner for Patents
Washington DC 20231

Dear Sir:

REPLY PURSUANT TO 37 CFR § 1.116

In response to the Final Official Action mailed September 10, 2002 in connection with the above-identified application, Applicants respectfully request that the application be amended and reconsidered in view of the following.

In the Claims:

Please amend claim 55 to read as follows:

55. (Amended three times) A method comprising:

generating *in silico* virtual compounds according to thermodynamic property, target accessibility, targeting to functional regions of target nucleic acid sequence, or uniform distribution to target nucleic acid sequence, wherein real compounds corresponding to said

DO NOT ENTER
AM, 11-27-02

virtual compounds modulate the expression of a target nucleic acid sequence;
synthesizing compounds corresponding to at least some of said virtual compounds;
and
robotically assaying said synthetic compounds for one or more desired physical,
chemical or biological properties by computer-controlled polymerase chain reaction or by
computer-controlled enzyme-linked immunosorbent assay.



Corres. and Mal.
BOX AF

AF
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EV160977710US

Box ☐ NON-FEE

☒ AF

Assistant Commissioner for Patents
Washington DC 20231

Sir:

REPLY TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ An Amendment Responsive to the Office Action Dated September 10, 2002.
- ☐ An Amendment Supplemental to the Paper filed _____.
- ☐ Other: _____
- ☒ Applicant(s) has previously claimed small entity status under 37 CFR §1.27.
- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR §1.27 as:

- ☐ an Independent Inventor
- ☐ a Small Business Concern
- ☐ a Nonprofit Organization

- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the Patent and Trademark Office.

- ☐ Substitute Pages _____ of the Specification are enclosed.

- ☐ An Abstract is enclosed.

- ☐ _____ Sheets of Proposed Corrected Drawings are enclosed.

- ☐ A Certified Copy of each of the following applications: _____
_____ is enclosed.

- ☐ An Associate Power of Attorney is enclosed.

- ☐ Information Disclosure Statement.
 - ☐ Attached Form 1449.
 - ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.

- ☐ Appended Material as follows: _____ .

- ☐ Other Material as follows: _____ .

FEE CALCULATION

☒ No Additional Fee is Due.

				SMALL ENTITY		NOT SMALL ENTITY	
	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	FEE	RATE	FEE
TOTAL CLAIMS	35	54 (20 MINIMUM)	0	\$9 EACH	\$0	\$18 EACH	\$
INDEP. CLAIMS	29	45 (3 MINIMUM)	0	\$42 EACH	\$0	\$84 EACH	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$140	\$0	\$280	\$
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$55	\$0	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$200	\$0	\$400	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$460	\$0	\$920	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$720	\$0	\$1440	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$980	\$0	\$1960	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$)	minus	(\$)
<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$0	\$110	\$
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:							
TOTAL FEE DUE					0		\$


- ☐ A Check is Enclosed in the Foregoing Amount Due.
- ☐ Petition is hereby made under 37 C.F.R. 1.136(a) to extend the time for response to the Office Action of @@ to and through @@ comprising an extension of the shortened statutory period of @@ month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to deposit

account 23-3050. This sheet is provided in duplicate.

- ☒ The Commissioner is authorized to charge payment of the following fees and to refund any overpayment associated with this communication or during the pendency of this application to deposit account 23-3050. This sheet is provided in duplicate.
- ☐ The Foregoing Amount Due for Filing this Paper.
- ☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 C.F.R. 1.16.
- ☒ Any additional patent application processing fees under 37 C.F.R. 1.17 or 1.20(d).

SHOULD ANY DEFICIENCIES APPEAR with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the United States Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: November 12, 2002


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FEE CALCULATION:

- ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

				SMALL ENTITY		NOT SMALL ENTITY	
				RATE	FEE	RATE	FEE
PROVISIONAL APPLICATION				\$75.00	\$	\$150.00	\$
DESIGN APPLICATION				\$155.00	\$	\$310.00	\$
UTILITY APPLICATIONS BASE FEE				\$380.00	\$380.00	\$760.00	\$
UTILITY APPLICATION; ALL CLAIMS CALCULATED AFTER ENTRY OF ALL AMENDMENTS							
	No. Filed	No. Extra					
TOTAL CLAIMS	111- 20 =	91		\$9 each	\$819.00	\$18 each	\$
INDEP. CLAIMS	45- 3 =	42		\$39 each	\$1638.00	\$78 each	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM				\$130	\$130	\$260	\$
ADDITIONAL FILING FEE					\$0		\$
TOTAL FILING FEE DUE					\$2967.00		\$

- ☒ A Check is enclosed in the amount of \$ 2967.00.
- ☐ The Commissioner is authorized to charge payment of the following fees and to refund any overpayment associated with this communication or during the pendency of this application to deposit account 23-3050. This sheet is provided in duplicate.
- ☐ The foregoing amount due.
- ☐ Any additional filing fees required, including fees for the presentation of extra claims under 37 C.F.R. 1.16.
- ☐ Any additional patent application processing fees under 37 C.F.R. 1.17 or 1.20(d).
- ☐ The issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance.
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is